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December 21, 1999



Honorable Commissioner of Patents and Trademarks
U.S. Patent and Trademark Office
Washington, D.C. 20231

Re: Petition for the Institution of Public Use
Proceedings Under 37 CFR 1.292
Concerning Reissue Application SN 09/267,025
Our Ref: 20835/259165

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Dear Sir:

On December 8, 1999, the undersigned filed a Protest Under 37 CFR 1.291(a) together with a Petition for Institution of Public Use Proceedings Under 37 CFR 1.292.

Upon reviewing these documents, we found a number of typographical errors within them.

Specifically, with respect to the Protest, pages 3, 7, 8, 15 and 16 have been amended. The amended pages are attached hereto, the amendments being highlighted in bold and strike lines.

With respect to the Petition, page 3 has been amended. Amended page 3 is also attached hereto.

We respectfully request that you replace the original pages 3, 7, 8, 15 and 16 of the Protest and original page 3 of the Petition with the replacement pages attached hereto.

Please advise if you have any questions by contacting me (202/861-3794).

Thank you.

Yours very truly,

Jack Barufka
Registration No. 37087

Petitions. The evidence in the Public Use Proceedings Petition is hereby incorporated by reference, for the Examiner's consideration.



1.2 PRIOR TO THE FILING OF THE APPLICATION FOR THE '938 PATENT, THE INVENTION WAS "KNOWN" AND "USED" BY OTHERS IN THIS COUNTRY, SEE 35 U.S.C. § 102 (a) AND WAS MADE IN THIS COUNTRY BY ANOTHER WHO HAD NOT ABANDONED, SUPPRESSED OR CONCEALED IT, SEE 35 U.S.C. § 102 (g).

The invention was "made," "known," and "used" in this country by Visual Technologies, ~~Inc.~~, Inc. and Clear Choice Marketing, ~~Inc.~~, Inc. prior to the filing of the application for the '938 patent, on October 18, 1994. Specifically, the attached prior art of a Gatorade advertisement assembly (see Exhibit 1) was made in January 1994 by VTI for Clear Choice Marketing, ~~Inc.~~, Inc. CCM is the marketing organization that typically has sold product for VTI. This fact is supported by Linda Icard's Affidavit (attached as Exhibit 2), Ben Icard's Affidavit (attached as Exhibit 3), Mr Roland Hill's Affidavit (attached as Exhibit 4), Abigail Parker's Declaration (attached as Exhibit 5) and Pat Henrietta's Affidavit (attached as Exhibit 6).

This Gatorade advertisement assembly prior art was part of a 14,100 quantity order placed by MCA (Marketing Corp. of America) and shipped by Clear Choice Marketing, ~~Inc.~~, Inc. on January 31, 1994. The shipment is evidenced by the attached

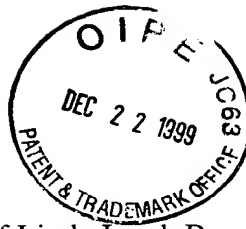


CLAIM CHART I

Proposed Claim 1. (Amended)	Gatorade Advertisement
"i) said perforated panel assembly appears substantially transparent when viewed from a first direction;"	The Gatorade advertisement (after removal of the perforated protective liner) appears substantially transparent when viewed from a first direction.
"ii) said image is clearly visible when said perforated panel assembly is viewed from a second, opposite direction;"	The Gatorade advertisement image is clearly visible when viewed from a second, opposite direction.
"c) a non-perforated backing layer removably attached to said perforated protective liner, wherein said non-perforated backing layer being effective to facilitate handling of said perforated panel assembly."	The Gatorade advertisement assembly has a non-perforated backing layer in the form of a substantially colorless plastic film attached to the perforated protective liner which is demonstrably removable from the perforated protective liner. The non-perforated backing layer to the perforated protective liner facilitates handling of the Gatorade perforated panel assembly when screenprinting the image and white and black layers, as described in Mrs Icard's Affidavit (Exhibit 2).

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This prior art sale is further supported by the printed and published article in POP TIMES dated June 1996 attached as Exhibit G to the Affidavit of Ben Icard (Exhibit 3 herein). This article refers to the product being "ImagoImageTM" which is a trademark of ImagoImage, Inc., as evidenced by the letter from ImagoImage, Inc. to Contra Vision Ltd of May 17, 1994, attached to Mr Hill's Affidavit (Exhibit 4) as Exhibit A. The ImagoImage, Inc. letter is signed by Mr Gregory E Ross, the same Mr Ross who is party to the ~~1998~~ ¹⁹⁹⁸ patent reissue application.



As evidenced by the Affidavits of Linda Icard, Ben Icard and Pat Henrietta (see Exhibits 2, 3 and 6, respectively), independent claims 1 and 15 are anticipated under 35 U.S.C. 102 (a) and 102 (g), because many thousands of products disclosing all the features of both claim 1 (as granted and amended) and claim 15 (as proposed) were “made”, “known” and “used” by others in this country before October 18, 1994. They also provide evidence of the sale of clear, transparent static cling assemblies disclosing all the features of claim 5 and claim 6 (Amended).

2.0 RECAPTURE OF CANCELED SUBJECT (35 U.S.C. 251)

Claims sought in reissue should not be granted to “recapture” claimed subject matter deliberately canceled in an application to obtain a patent, see 35 U.S.C. 251. The Office Action dated September 23, 1999 identifies why claim ~~1~~ 15 as amended is not allowable under 35 U.S.C. 251, for reasons the Protestor endorses.

During the prosecution of the original application that issued into the '938 patent, the Applicant made several attempts to claim and cover one-way vision display assemblies having light reflecting and light absorbing layers that would fall within proposed claim 15. However, the Applicant was unsuccessful in pursuing such claims and canceled them. The Applicant is now attempting to recapture the forfeited subject matter. Specifically, the product that the Applicant attempted to cover is exemplified by claim 63 pursued but canceled in the original application, and now by claim 15 in the

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Support for the perforated assembly with perforated protective liner as recited in claim 15 is found in exterior mount embodiment shown in Fig. 7 and the discussion of the fabrication method for the exterior mount embodiment in the specification at Column 3, lines 56 – 66 and the alternate embodiment discussed at Column 4, lines 43 – 48.”

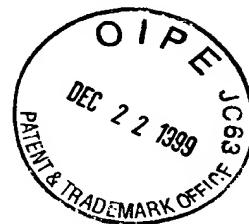
This is not the case. Specifically, Fig. 7 does not disclose a perforated ~~rotected~~ protective liner. The protective liner 54 is disclosed as being imperforate. Also, Fig. 7 does not show an assembly with a perforated adhesive layer; the adhesive only has portions removed upon removal of the protective liner 54.

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In addition, Column 3, lines 56 – 66, does not disclose the features of claim 15. Column 3, lines 56 – 66, discloses “the light-reflective image panel” and the light-absorbing layer “are bonded to the opposite sides of an intermediate white opaque panel.” It is clear that “the light-reflective image panel” refers back to Column 3, lines 19 – 23 wherein it is stated that “the image is placed on the first panel.” Therefore, the patent specification makes it clear that the light absorbing layer is applied to the back of the white opaque panel and the image is applied to a separate “image panel”. In contrast, proposed claim 15 attempts to cover a light reflective image applied to the front surface and a light absorbing layer applied to the rear surface of the same membrane, which is very different to the disclosure.

In addition, Column 4, lines 43 – 48 describes an assembly with “a single perforated membrane, preferably flexible plastic sheet material.” There is no related

disclosure of an adhesive, perforated or otherwise, or a protective liner, perforated or otherwise.



In sum, there is no disclosure to support proposed claim 15.

4.0 ANTICIPATION

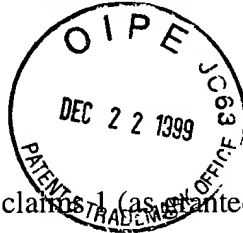
Claims 15 and 16 are anticipated by US B1 4,673,609, col. 13, lines 27 to 49 and Fig. 25, col. 19, line 64 to col. 20, line 18 and claim 36 dependent on claim 15 following reexamination. While claim 36 does not state that the perforated material which "comprises at least two layers" requires one of these layers to be "light absorbing," it is a consistent feature throughout the '609 patent that products of the invention typically have a black or dark layer to facilitate through-viewing from the other side to the one side bearing a design (see col. 1, lines 52 – 26, col. 4, lines 20 – 23 and col. 6, line 57, col. 7, line 7). Of course, any design must be "light reflective" in order to be visible. See the above references in the '609 patent and col. 15, lines 44 – 50 and col. 17, lines 53 – 60.

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Claims 15 and 16 should therefore be rejected as anticipated by US B1 4,673,609.

Independent claims 1 (amended) and as granted and proposed claim 15 were anticipated by products "in public use" and "on sale" in the USA over one year before the application of this patent, as were several dependent claims, as shown in the Public Use Proceedings Petition, filed concurrently herewith. Claims 1 and 15 and other claims

application, Mr Rodney Shields, and the authorized representative of the assignee, Mr Gregory E Ross, while they were both stockholders and officers in the company ImagoImage, Inc. of California, as referred to in the Affidavits of Linda Icard and Ben Icard (attached as Exhibits 2 and 3).



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The invention as claimed in claims 1 (as granted and as amended), 4, 5 (as granted and as amended) and 6 (as granted and as amended) was conceived and reduced to practice by Linda Icard of Visual Technologies, ~~Inc.~~, Inc. (hereinafter referred to as VTI) in the period from August 10 to September 28, 1993. The invention as claimed in claims 15 and 16 was reduced to practice by Linda Icard of VTI in the period from August 16 to September 30, 1993. The invention was put "in public use" and "on sale" by VTI and Clear Choice Marketing, Inc. (hereinafter referred to as CCM), both of 10920 Southern Loop Boulevard, Pineville, North Carolina, on many occasions from August 16 to October 17, 1993. These instances of invention, reduction to practice and placement "in public use" and "on sale" before October 18, 1993 are supported by the attached prior art assembly of an offcut of an "Old Joe" advertisement in Exhibit 1 and the Affidavits of Linda Icard (attached as Exhibit 2), Ben Icard (attached as Exhibit 3), Pat Henrietta (attached as Exhibit 6) and Roland Hill (attached as Exhibit 4) and the Declaration of Abigail Parker (attached as Exhibit 5).

The offcut of the "Old Joe" advertisement assembly attached hereto as Exhibit 1 is a prior art offcut supplied by Linda Icard. Other offcuts of this assembly have been incorporated into the Affidavits of Linda Icard and Ben Icard, the remainder of this assembly being held by Linda Icard,